



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,676	08/31/2001	Daniel Keele Burgin	FINL-005/00US	8505
22903	7590	03/14/2005		
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			EXAMINER CHRISTMAN, KATHLEEN M	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/944,676		BURGIN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Kathleen M Christman		3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/07/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3713

### **DETAILED ACTION**

In response to the amendment filed 12/07/2004, claims 24-30 have been cancelled; claims 37-44 and newly added claims 45-53 are pending.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/2004 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 37-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

### ***Technological Arts Analysis:***

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful

Art Unit: 3713

arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 37-52 fail to apply, involve, use or advance the technological arts. Regarding claims 37 and 45, the recited steps of passing a navigation event from a first frame to a second frame; determining a navigation location, and initiating an automated help session do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to initiate a help session and do not necessarily incorporate a computer system, its standard components, or any other technological components.

Claim 53 incorporates the technological arts by requiring that at least one of the steps be performed at the user computer.

*Useful, Concrete and Tangible Analysis:*

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claimed method fails to produce a tangible result. The claimed method steps, of the independent claims, results in "initiating an automated help session"; this initiation step fails to show any practical application of the method. Although it is asserted that the help session may be useful in providing user support, the method does not show a tangible result. A result is not tangible when the claims involve no more than the manipulation of an abstract idea. The claimed method merely manipulates data without actually applying the manipulated data in a real-world result. Dependent claims 38-44 and 46-52 fail to correct this issue as they do not add any steps, which incorporate the production of a tangible result.

Art Unit: 3713

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 37, 39, 40, 42, 45, 47, 48 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Brandt et al (US 2002/0130895 A1). Brandt teaches a method for providing help/support information to user including the steps of: passing a navigation event (the help signal paragraph 29) from a first frame (web page) originating from a first domain (the web file) to a second frame (the help window, paragraph 13) originating from a second domain (the instructions in the computer memory), see paragraphs 36 and 37; determining the present navigation location within the first frame using the navigation event and initiating an automated help session in the second frame, the automated help session corresponding to the determined present navigation location (paragraph 31), as in **claims 37 and 45**.. Collecting data from the first frame that was collect from the user in the first frame and passing the received information to the second frame (**claims 39, 42, 47 and 50**) is shown in the tracking of the user actions in the web page, see paragraph 45. The web page of Brandt is by definition a content frame, as per **claims 40 and 48**.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3713

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 38, 41, 43, 44, 46, 49, 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al (US 2002/0130895 A1) in view of Jawahar et al (US 6256620 B1).**

Brandt teaches all features of the claimed invention as shown above, but fails to specifically teach: initiation a live help session and passing the data from the automated help session to the live help session (**claims 38 and 46**); passing a command from the automated support session to the first frame (**claims 41 and 49**); receiving data that was collected in the live help session and passing the data to the first frame (**claims 43 and 51**); receiving data collected from the user in the second frame and passing the data to the live help session (**claims 44 and 52**); and that the user's computer, first Internet domain, and second Internet domain are separate (**claim 53**).

Jawahar et al teaches on online system for providing live support to a end-user. The system teaches collecting all interaction of a user on a web page (content frame) and passing this information to the live support session in at least col. 12: 65 - col. 13:23. These features are substantially similar to the data collection and passing steps not taught by Brandt. The ability for the help session to send information to the user's computer, i.e. passing information from the help session to the content frame, is shown in col. 7: 37-40. The Jawahar et al system monitors all user interactions, which in the combination of the inventions, includes those interactions made with the automated help system of Brandt et al. Separation of each of the various features of Jawahar is taught in at least Figure 2. It would have been obvious to one of ordinary skill in the art to implement the live help session features of Jawahar et al with the automated help system of Brandt et al so as to implement a convenient means for a user

Art Unit: 3713

encountering difficulties with a web page to contact a live representative to gain assistance (Jawahar et al, background).

### ***Response to Arguments***

4. The previous rejections under 35 USC §112, first and second paragraph have been withdrawn in view of the remarks found in the response dated 10/14/2004.

#### **New claims 45-52**

Applicant has failed to mention how the new claims are believed to read over the prior art of record. The examiner believes that the arguments pertinent to the definition of "domain" are applicable to the new claims.

#### **Response to arguments concerning the rejection of claims under 35 USC §102**

Applicant's only arguments are directed to the feature of having a first and second domain, or Internet domain as in claims 45 and 53. The applicant has provided several definitions of the term "domain" but has not specifically defined an "internet domain". The examiner believes these terms are directed to substantially similar features. It seems to be generally agreed that the general step of loading a web-page in a first frame constitutes the information from the first domain. So the issue at hand is what constitutes the second domain of the Brandt et al system. The Brandt et al system is connected to the Internet or some other network in a conventional manner. In order for this to occur the computer must inherently be assigned an IP (Internet Protocol) address through which the system is capable of establishing bi-directional communication to the user's internet service provider (ISP) and other various server's and domain throughout the networks. The IP is assigned by the user's ISP and is within the domain of the ISP. Given this, any information retrieved through the user's computer is implicitly "originating from a second domain", and the feature of Brandt et al matches the limitations of the currently claimed invention.

### ***Conclusion***


Art Unit: 3713

This action is made non-final in view of the new rejections made under 35 USC §101.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen M Christman  
Examiner  
Art Unit 3713